



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/761,378	01/16/2001	Teiji Mizutani	892_014	5329
25191	7590	07/20/2005	EXAMINER	
BURR & BROWN			DURAN, ARTHUR D	
PO BOX 7068			ART UNIT	
SYRACUSE, NY 13261-7068			PAPER NUMBER	

3622

DATE MAILED: 07/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/761,378

Applicant(s)

MIZUTANI, TEIJI

Examiner

Arthur Duran

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-11 have been examined.

Response to Amendment

2. The Amendment filed on 6/13/05 is sufficient to overcome the LaLonde, Rogers, and Eggleston reference.

Continued Examination Under 37 CFR 1.114

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/13/05 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maggio (6,606,745) in view of Gardenswartz (6,055,573)

Art Unit: 3622

Maggio discloses initiating contact with prospective customers via an unsolicited advertisement, controlling notice of prize or award information, registering attributes of applicant's for prize information, creating content data in accordance with attributes of the applicant information, transmitting the content data to the user (Fig. 2).

Maggio further discloses targeting a user based on information known on a user and providing attained user information for the purposes of targeting a user and also registering a user in order to attain user related information:

"Targeted advertising focuses on delivering specific, personalized advertising to the Consumers that meet a demographic profile specified by the Advertisers. Mass media advertising is usually less expensive per impression than targeted advertising. However, targeted advertising is usually more effective, and has become less expensive per impression as technology has progressed. As a result, the effectiveness of mass media advertising has been questioned (col 2, lines 10-18);

(16) The Promoters can sell the CRAV Ads to the Advertisers. The Promoters or the Advertisers can use the Broadcast Network to promote future CRAV Ads. The Promoters can use the Broadcast Network, the Device, the Information Gathering System, and the Data Storage Center to communicate the CRAV Ads to the Consumers and to interact with the Consumers. The Promoters or the Advertisers can use the Device, the Information Gathering System, and the Data Storage Center to gather the Consumers' responses to the CRAV Ads. The Promoters can edit and/or distribute the registration and response information to the Advertiser or other interested third parties. The Promoters can select the winners and distribute the prizes (col 3, lines 12-25);

Art Unit: 3622

(38) In another exemplary embodiment for registration, the Promoters may wish to obtain ID information, product-related information, or public opinion-related information. The demographic profile of each Consumer 110 may include age, sex, race, weight, height, zip code, physical home or e-mail address, occupation, individual annual earning, educational background, political affiliation, religious affiliation, family size, number of TVs and computers, Advertiser-related or public opinion survey questions, and prior CRAV Ad answers (historical response information). A detailed registration may be required for each CRAV Ad. However, gathering this information for each CRAV Ad makes the registration process time-consuming, costly, and redundant, and may deter the Consumers 110 from submitting a response. Thus, a one-time registration process is also available. In this mode, only changed/updated demographic or ID information (such as a change in marital status, phone number, etc.) is added for each CRAV Ad response after the original registration. Under this scenario, the original registration information is stored in the PDC 197. As new responses or update information are transmitted to the Data Storage Center 195, the Data Storage Center 195 is updated (col 10, lines 40-62).

(39) In another alternative embodiment for registration, when only one registration is used (as described above), the Advertisers may have the Consumers 110 with existing CRAV IDs enter additional demographic information to be qualified for the rewards. In this case, new "response" information is added for each additional CRAV Ad response after the original registration. Under this scenario, the original registration information would be stored in the DCS 196, and as new responses are transmitted to the Data Storage Center

Art Unit: 3622

195, the Data Storage Center 195 would be added to the registration information. The CRAV ID would be required before allowing additions to CRAV Ad records" (col 10, line 62-col 11, line 5).

Also, Gardenswartz further discloses utilizing prizes to incite certain user behavior:

"(53) One type of targeted advertisement that can be delivered in step 82 is a value contract. The value contract is a promotional incentive in which the consumer is offered a reward for complying with a particular behavioral pattern such as a predefined change in behavior or the continuance of an established behavior. Any type of reward may be offered. The reward may be "points" which may correspond to, or be redeemed for, cash, cash equivalents, frequent flier miles, minutes of long distance time, minutes of Internet service provider time, coupons, discounts, prizes, or free products, for example" (col 14, lines 50-60).

Gardenswartz discloses determining user preferences including brand or product type/category and also registering a user:

"(35) In step 60, the consumer's Web browser jumps to a registration Web page served by the registration server 14. Then, in step 62, the consumer registers online with the registration server 14 and, in the process, provides the registration server 14 with information, including an identifier found in the master record 30 (e.g., the consumer's CID). The consumer may supply the registration server 14 with information about the consumer to generate an online profile for the consumer. The online profile may include information such as the consumer's name CID, e-mail address, product/brand preferences, demographic information, work address, home address, whether the consumer has any babies, and whether the consumer has any pets such as a cat, dog, bird, or fish. Preferably, the online profile includes at least one

Art Unit: 3622

item of information that is stored (or is to be stored) in the purchase history database 8" (col 11, lines 35-51).

Gardenswartz discloses targeting a user based on the information attained about a user:

"(43) In step 74, the analytics unit 16 sends to the registration server targeted ad profiles for each consumer identified in step 68. Each of the targeted ad profiles includes the consumer's CID and the purchase behavior classification(s) corresponding to that CID. The targeted ad profiles may be stored in a table such as an array or table of records, linked lists, or other suitable data structure" (col 13, lines 5-11).

Gardenswartz discloses utilizing information known about commercial articles for matching what content or content type or commercial article or commercial article type to send to a particular user:

"(19) The targeted ad profile 446 includes three fields, 449a, 449b, and 449c, for three purchase behavior classifications: Brand Z loyalty, Heavy Snacker, and Healthy Household, respectively. Each purchase behavior classification may be given any score (e.g., an integer), a describer (e.g., "Brand Z loyalist" or "Heavy Brand Z User"), flag ("1" or "0"), or rank (e.g., "50.sup.th out of 50,000) that the consumer has received based on selected purchase behavior criteria which are discussed below with reference to FIG. 8 (col 9, lines 5-15);

(39) For example, the criterion for a class of "heavy Brand Z drinkers" may be defined as any consumer who has purchased Brand Z at least twice a year in the last month. As another example, the criterion for a class of "Brand Z loyalists" may be defined as any consumer who has purchased Brand Z at least once a month for the last nine months. Regardless of how different criteria are determined, the criteria are preferably based on information derived from

Art Unit: 3622

marketing research. The purchase behavior criteria do not necessarily have to originate from the advertiser's server 18, but may originate from any suitable remote device such as the computer 26, the Web server 24, and/or the registration server 18" (col 12, lines 42-56).

Gardenswartz further discloses that second additional content data based on applicant information that allows a user to access other sets of content data:

"(34) Thus, a cookie can be assigned when a first Web page provided by the advertiser's server 18 is requested by the first computer 10. The first Web page can contain a link to a second Web page provided by the registration server 14. When the consumer selects the link to the second Web page, the cookie number can be placed in the URL statement for the second Web page, and thus sent to the registration server 14 (col 11, lines 27-35);

(9) Since cookies are also used to track a consumer's online activity, a Web server can deliver targeted advertisements to a consumer's Web browser, based on the consumer's online activity. For example, if a cookie tracks the various IP addresses accessed by the consumer's computer, the Web server can deliver ad banners to the consumer's Web browser based on the IP addresses the Web browser has accessed. Thus, the cookie can be used to record the online activity of a consumer, and information regarding the consumer's tastes and tendencies can be inferred from the consumer's online activity. Using this inference, an advertiser can try to target specific advertisements to specific computer consumers, based on the record of the computer consumers' online activities. That is, the advertiser can try to expose the computer consumers to advertisements designed to appeal to their particular tastes and interests;

(10) The targeted advertisement can be implemented in several manners. For example, the advertiser can generate Internet banners that contain targeted ads and are visible to the

Art Unit: 3622

consumer when the consumer accesses the advertiser's server, and/or the advertiser can automatically generate e-mail messages and send them to the consumer if the advertiser has the consumer's e-mail address" (col 2, lines 20-42).

Examiner takes Official Notice that it is old and well known that a banner or banner advertisement is an advertisement on a Web page that contains a link to the advertiser's Web site. Also, the Microsoft Press Computer Dictionary 3rd Edition states that a banner or banner advertisement is an advertisement on a Web page that contains a link to the advertiser's Web site.

Hence, notice in the above citations from Gardenswartz that Gardenswartz's providing of banner advertisements with links to further information where the banners and further information are provided to the user because of information known about the user is equivalent to providing second sets of data wherein the content contains a piece of information for accessing other sets of content. Gardenswartz's banner provides a link that is a piece of information for accessing other or additional content data.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Gardenswartz's further features for utilizing of user information in order to target a user to Maggio's collecting of information on a user for targeting a user. One would have been motivated to do this in order to make better use of the information collected in order to better target a user.

Art Unit: 3622

Response to Arguments

5. Applicant's arguments with respect to claims 1-11 have been considered but are moot in grounds of the new rejection.

Examiner notes that while specific references were made to the prior art, it is actually also the prior art in its entirety and the combination of the prior art in its entirety that is being referred to.

Examiner further notes that it is the Applicant's claims as stated in the Applicant's claims that are being rejected with the prior art. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Also, Examiner notes that claims are given their broadest reasonable construction. See *In re Hyatt*, 211 F.3d 1367, 54 USPQ2d 1664 (Fed. Cir. 2000).

And, on page 6, Applicant states, "The cited references fail to disclose or suggest a system that initiates contact with a previously unregistered user by displaying an image or other advertisement". Please see the rejection above to see how these features are addressed.

Also, Examiner notes that a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Art Unit: 3622

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (571) 272-6718. The examiner can normally be reached on Mon- Fri, 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Arthur Duran
Patent Examiner
7/18/2005